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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
08/407,595	02/22/95	CARRERA GARRIDO	J 7723/0A275

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NEW YORK NY 10022

12M2/0320

WILLIAMSON, M	
ART UNIT	PAPER NUMBER
1207	#7

DATE MAILED:

03/20/96

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents



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EXAMINER

ART UNIT

PAPER NUMBER

7

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

DATE MAILED:

☒ This application has been examined    ☒ Responsive to communication filed on 12/04/95    ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 MONTHS from the date of this letter.  
Failure to respond within the time period will cause the application to become abandoned. 35 U.S.C. 133

**Part I THE FOLLOWING ATTACHMENTS ARE PART OF THIS ACTION:**

- |   |  |
|---|--|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892.        | 2. <input type="checkbox"/> Notice re Patent Drawing, PTO-948.                   |
| 3. <input checked="" type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449   | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____  |

**Part II SUMMARY OF ACTION**

1. ☒ Claims 1-20 are pending in the application.  
Of the above claims, 2, 4-17 and 19 are withdrawn from consideration.
2. ☐ Claims \_\_\_\_\_ have been cancelled.
3. ☐ Claims \_\_\_\_\_ are allowed.
4. ☒ Claims 1, 3, 18 and 20 are rejected.
5. ☐ Claims \_\_\_\_\_ are objected to.
6. ☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable. ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_ has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed on \_\_\_\_\_ has been ☐ approved. ☐ disapproved (see explanation).
12. ☒ Acknowledgment is made of the claim for priority under 35 USC 119. The certified copy has ☐ been received ☒ not been received  
☐ been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

**EXAMINER'S ACTION**

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### **Part III     DETAILED ACTION**

#### ***Election/Restriction***

1.    Claims 2, 4-17 and 19 are withdrawn from further consideration by the examiner, 37 C.F.R. § 1.142(b) as being drawn to a nonelected species. Election was made **without** traverse in Paper No. 6.

#### ***Claim Rejections - 35 USC § 101***

2.    35 U.S.C. § 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".

The law does not permit the claiming of an invention in terms of "use". Clinical Products Ltd. v Brenner, Commr., Patents, 149 USPQ 475.

#### ***Claim Rejections - 35 USC § 112***

3.    Claim 3 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. There lacks antecedent basis for the recitation of "sclerosing substance" deeming the claims vague and indefinite.

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4. Claims 18 and 20 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The law does not permit the claiming of an invention in terms of "use". Clinical Products Ltd. v Brenner, Commr., Patents, 149 USPQ 475. "Using/Use" does not describe a process step. Ex parte Dunki, 153 USPQ 678. The claims do not need to recite all of the operating details, but a method claim should at least recite a positive, active step so that the claim will "set out and circumscribe a particular area with a reasonable degree of precision and particularity," In re Moore, 169 USPQ 236, and make it clear what subject matter the claim encompasses, as well as make clear the subject matter from which others would be precluded. In re Hammack, 166 USPQ 204.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102

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of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

6. Claims 1 and 3 are rejected under 35 U.S.C. § 103 as being unpatentable over Applicant's admission in view of Hilmann et al. Applicant admits that mixing sclerosing agents with air to form bubbles is known (see page 1, line 25 to page 2, line 4). Applicant does not admit that the bubbles formed are microfoam. Hilmann et al. discloses forming injectable microfoam. The advantage of the microfoams taught by Hilmann et al. are higher viscosity, extended useful lifetime and increased amount. Therefore, it would have been obvious to one of ordinary skill in the art to use the teachings of Hilmann et al. in the invention admitted to by Applicant to make a injectable microfoam of a sclerosing agent having a higher viscosity, extended useful lifetime and increased quantity.

7.

#### **Crystal Mall 1 Fax Center**

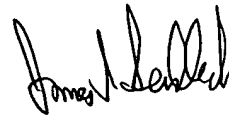
A facsimile center has been established in Crystal Mall 1, rooms 4E18 and 3C10. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier numbers for accessing the facsimile machine are (703)308-4734 and (703) 308-4556. The new location should be used in all instances when faxing any correspondence to Group 120. Use of the new Crystal Mall 1 center will facilitate rapid delivery of materials to the Group. The faxing of all papers must conform with the notice published in the Official Gazette, 1096 O.G. 30 (November 15, 1989).

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael A. Williamson whose telephone number is (703) 308-1235.



**JAMES J. SEIDLECK**  
**SUPERVISORY PATENT EXAMINER**  
**GROUP 1200**

Williamson960318  
March 18, 1996